

2 wherein when the electrical circuit is in the energized state the lighting elements are illuminated and when in the deenergized state the lighting elements are not illuminated.--

REMARKS

The Examiner has indicated that claims 1-19 are subject to restriction or election. Specifically, the Examiner has indicated that three distinct species of the claimed invention are disclosed in the present application, namely, Group I drawn to figures 1-8, Group II drawn to figures 6-9, and Group III drawn to figures 11-13. The Examiner has also indicated that claim 16 is generic to these three species of the invention.

Applicant hereby elects to prosecute the species of Group III, as indicated in FIGs. 11-13. Claims 16-19 are representative of the species of Group III. In addition, new claim 20, which claim is added by this amendment, is readable on the species of Group III.

Applicant makes this election with traverse.

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a). The Examiner has indicated that the features claimed but not apparent to the eye from the drawings, for example, particular assembly steps (claims 13-15), a particular layer that is "polyurethane" (claims 9 and 10), a "timer" (claim 19), and a force actuatable switch (claim 18), must be shown or the features cancelled from the claims. The Examiner has suggested that suitable labels can be applied to the drawings, as shown by Smith et al.

Submitted concurrently herewith is a Request for Drawing Change in which labels have been applied to figures 2 and 13 of the drawings. If these changes are acceptable to the Examiner, Applicant will formalize these changes in the drawings upon indication of allowable subject matter in the present application.

With respect to the Examiner's notation that more informative structural details at the point of novelty must be provided in the abstract, Applicant would request that the undersigned and the Examiner discuss this matter during a telephone interview. Unless objected to by the Examiner, Applicant's attorneys will contact the Examiner to discuss language to be added to the abstract

acceptable to the Examiner.

The Examiner has next rejected claims 1-19 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Smith et al., U.S. Patent No. 3,458,205.

The Examiner states that “[a]s understood, only inherent features of the reference golf balls claimed.” The Examiner further states that the burden is on applicant to show that inherence is not involved.

Applicant has as stated above, elected to prosecute claims 16-19 in the present application, along with new claim 20, which claims, collectively, are directed to the embodiment of the invention as indicated in Group III, as represented by FIGs. 11-13. To this end, Applicant will discuss only amendments to these elected claims and will forego any discussion of claims 1-15 in anticipation that these claims will be canceled upon indication of allowable subject matter in the pending claims 16-20.

Applicant has amended claim 16 to more particularly point out and distinctly claim the subject matter of the invention. Specifically, Applicant has amended claim 16 to indicate that the illuminatable ball has a sealed outer translucent shell and includes a timer actuated switch that is separate and distinct from the energy source, e.g., the battery. Applicant has further amended claim 16 to indicate that the switch is switchable from the deenergized state (wherein the lights are not illuminated) to the energized state (wherein the lighting elements are illuminated) for a set, predetermined period of time.

The set predetermined period of time during which the switch remains actuated or energized, is distinct from any switching function that a battery may have as implied by the Examiner. In addition, Applicant has specifically recited that the switch is, in fact, separate and distinct from the energy source or battery. A battery as an energy source may maintain lights illuminated for a period of time, but only insofar as the battery remains with power. Upon using the power of the battery, Applicant believes that it is the Examiner’s position that the lighting elements will thus turn off, in which case the battery serves as a switch. Applicant’s invention utilizes an energy source, such as a battery, but in addition, utilizes a separate and distinct switch to energize

or de-energize the light elements. To this end, unlike the case where a battery is merely connected to the lighting elements and the lighting elements remain illuminated until loss of power of the battery, in the present invention, the power source is disconnected from the light elements by a timer and can be subsequently re-energized so that the lights may be lit and unlit cyclically.

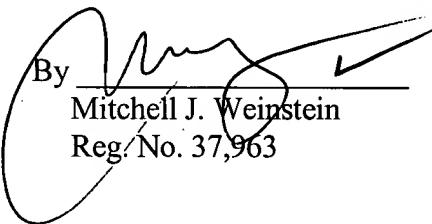
Applicant submits that the invention as claimed in amended claim 16 is not disclosed in Smith et al., nor would it have been obvious to one of skill in the art at the time it was made, given the Smith et al. reference in-hand. To this end, Applicant respectfully requests reconsideration and allowance of claim 16, and claim 18 which depends therefrom.

Applicant has added new claim 20 which, Applicant submits is allowable over the art of record including Smith et al. and for which Applicant respectfully requests consideration and allowance.

In conclusion, Applicant respectfully requests expeditious allowance of claims 16, 18, & 20 in view of the above-noted amendments and remarks. Should the Examiner believe that a telephone interview would expedite prosecution of the present application, he is requested to contact the undersigned.

Respectfully submitted,

**WELSH & KATZ, LTD.**

By   
Mitchell J. Weinstein  
Reg. No. 37,963

July 19, 1999  
**WELSH & KATZ, LTD.**  
120 South Riverside Plaza, 22<sup>nd</sup> Floor  
Chicago, Illinois 60606  
(312) 655-1500 Telephone  
(312) 655-1501 Facsimile